

Serial No. 10/553,132

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Art Unit 2872

Amendment under 37 C.F.R. § 1.116(c)35 USC 102(b)

35 USC 102(b), note 141 includes the following text:

"Anticipation", a term of art within patent law, means disclosure in prior art of thing substantially identical with the claimed invention, and finding a patent "anticipated" by a disclosure in the prior art results in invalidation. *Smith v. ACMA General Contractors*, C.A.Ohio 1980, 614 F.2d 1086.

Anticipation of invention occurs only when some single prior article, patent, or publication contains within its four corners every element of claim in question; patent is not anticipated when its elements are distributed among several prior publications or devices. *Paeco, Inc. v. Applied Mouldings, Inc.*, C.A. Pa. 1977, 562 F.2d 870.

MPEP 706.02 Rejection of Prior Art [R-6], V. Distinction between 35 U.S.C. 102 and 103, reads:

The distinction between rejections based on 35 U.S.C. 102 and those based on 35 U.S.C. 103 should be kept in mind. Under the former, the claim is anticipated by the reference. No question of obviousness is present. In other words, for anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present. Whereas, in a rejection based on 35 U.S.C. 103, the reference teachings must somehow be modified in order to meet the claims. The modification must be one which would have been obvious to one of ordinary skill in the art at the time the invention was made. See MPEP § 2131 - § 2146 for guidance on patentability determinations under 35 U.S.C. 102 and 103.

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Art Unit 2872

Amendment under 37 C.F.R. § 1.116(c)

Applicant argues that the single claim of US Pat. No. 5,864,428 does not teach, either explicitly or impliedly, "an optical device comprising a first combination of birefringent prisms with parallel optic axes for dividing an optical input beam into polarized beams, a second combination of birefringent prisms with parallel optic axes for combining polarized beams into an output beam, and a polarization changer disposed between said first combination of birefringent prisms and said second combination of birefringent prisms, wherein each birefringent prism of each said combination of birefringent prisms has oblique input and output faces".

The optical device of the pending application is not a polarizing device (as is the device of US Pat. No. 5,864,428) but merely uses a polarizing device in its operations. A "polarization changer" is an essential element of the device of the pending application, allowing it to operate as an optical isolator, attenuator, circulator or switch. There is no polarization changer present in the polarizer of US Pat. No. 5,864,428.

Applicant argues that US Pat. No. 5,864,428 does not qualify as prior art under 35 USC 102(b), as US Pat. No. 5,864,428 and the device of the pending application are not the same invention.

Yours sincerely,

*A. MR.*

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INVENTOR